

Applicants : Anne Marie Schmidt, et al.
U.S. Serial No: 10/666,513
Filed : September 19, 2003
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REMARKS

Claims 2 and 15 are pending and under examination in the subject application. Applicants have herein amended claims 2 and 15 to more particularly point out what they consider to be the invention. Support for the amendments to claims 2 and 15 can be found in the specification at, *inter alia*, page 6, lines 11 and 12, and Table 1 on page 36. Accordingly, upon entry of this Amendment, amended claims 2 and 15 will be pending and under examination.

The Claimed Invention

This invention provides an isolated EN-RAGE peptide comprising the amino acid sequence shown in SEQ. ID. NO:2.

This invention further provides a composition comprising an EN-RAGE peptide and a pharmaceutically acceptable carrier, wherein the peptide comprises the amino acid sequence shown in SEQ. ID. NO:2.

Rejection under 35 U.S.C. §102(b) and (e)

The Examiner rejected claim 15 as allegedly anticipated by European Patent Application No. EP 073116A2 ("Hitomi 1") under 35 U.S.C. §102(b) and by U.S. Patent No. 5,986,832 ("Hitomi 2") under 35 U.S.C. §102(e), respectively.

In response, applicants respectfully traverse.

In order for claim 15 to be anticipated by Hitomi 1 and Hitomi 2, the reference must teach each and every element of the instant

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claim. The references fail to do this.

The Examiner alleges that although Hitomi 1 and Hitomi 2 fail to teach a peptide having the amino acid sequence of SEQ. ID. NO:2, the cited references allegedly teach an amino acid sequence having certain regions identical to regions in SEQ. ID. NO:2. Therefore, a fragment of the peptide sequence taught in Hitomi 1 and Hitomi 2 could allegedly anticipate a peptide comprising a fragment of SEQ. ID. NO:2.

Without conceding the correctness of the Examiner's statements, applicants note that amended claim 15 does not recite "a fragment" of the peptide having the amino acid sequence shown in SEQ. ID. NO:2, and thus, neither reference teaches the claimed composition. Accordingly, applicants maintain that claim 15 satisfies the requirements of 35 U.S.C. §102(b) and (e).

Rejection under 35 U.S.C. §101

The Examiner provisionally rejected claim 2 as allegedly claiming the same invention as claim 2 in U.S. Serial No. 10/665,867.

In response, and without conceding the correctness of the Examiner's rejection, applicants will consider canceling claim 2 in U.S. Serial No. 10/655,867 once the rejection is made non-provisional.

Obviousness-Type Double Patenting Rejection

The Examiner provisionally rejected claim 15 under the judicially

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created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 15 of U.S. Serial No. 10/665,867.

Specifically, the Examiner alleges that although the conflicting claims are not identical, they are not patentably distinct from each other.

In response, and without conceding the correctness of the Examiner's rejection, applicants will consider filing a Terminal Disclaimer once the rejection of claim 15 is made non-provisional.

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 2 and 15 under 35 U.S.C. §112, second paragraph, as allegedly indefinite.

Specifically, the Examiner alleges that the phrase "having (or "has") the N-terminal amino acid sequence shown in SEQ. ID. NO:2" is unclear in specifying whether applicants intent "N-terminal amino acid sequence" to refer to SEQ. ID. NO:2 in its entirety or to an N-terminal portion thereof.

In response, and without conceding the correctness of the Examiner's rejection, applicants respectfully traverse, noting that claims 2 and 15 do not recite the language objected to by the Examiner. Accordingly, applicants maintain that claims 2 and 15 satisfy the requirements of 35 U.S.C. §112, second paragraph.

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Summary

In view of the remarks made herein, applicants maintain that the claims pending in this application are in condition for allowance. Accordingly, allowance is respectfully requested.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment
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P.O. Box 1450
Alexandria, VA 22313-1450

Alan J. Morrison
Reg. No. 37,399

Date

5/10/05

John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
Tel. No. (212) 278-0400